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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,943	06/15/2001	Kiril A. Pandelisev	PHOENIX SCIENTIFIC	5959

7590

05/04/2005

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EXAMINER
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LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/880,943

Applicant(s)

PANDELISEV, KIRIL A.

Examiner

Carlos Lopez

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004 and 16 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-240 is/are pending in the application.
- 4a) Of the above claim(s) 1-108, 123-127 and 136-240 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 109-122 and 128-135 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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After further consideration, the indicated allowability of claims 109-122 and 128-135 is withdrawn. The examiner's amendment canceling the non-elected claims will not be entered.

### ***Drawings***

The amendment filed to the drawings on 12/6/04 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The new drawings of figures 5-7.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Election/Restrictions***

The Applicant again traverses the requirement of restriction because the invention is unitary. Applicant notes, "To the extent that any claim should be searched in any art all of the claims should be searched in the same art. The Examiner has, for the first time, stated that there would be a serious burden, but has not provided examples."

This is not found persuasive because applicant failed to give reasons as to why a method and apparatus for making silica and a hollow body, rod, tube, or plate have different modes of operation and or different functions such as for the use as a mixer in glass melt furnace. In regards to applicant arguing sub-combination and combination, it is unclear to what said argument is being directed to, since a holding of sub-combination and combination has not been made. In regards to the argument that the restricted species are not patentably distinct, applicant should submit evidence or

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identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case (See MPEP 808.01(a)).

In regards to the argument that no serious burden has been established, applicant is directed to MPEP 803 which states "a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02." Hence, as noted in the restriction requirement groups one and two have separate classification and different field of search thus a prima facie case has been established. .

Hence the requirement is still deemed proper and is therefore still made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 109-122 and 128-135 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for depositing silica particles onto optical fiber preform rods, does not reasonably provide enablement for depositing silica particles onto a generic substrate. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The scope and/or breadth of

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claim reads on silica deposition onto any form or type of substrate when in fact the only type of substrate the specification provides is for a optical fiber preform. A person of ordinary skill in the art would not be able to make and use the claimed invention with regards to flat shape substrates, since it requires undue experimentation to determine the rotational speed the flat substrates, and temperature of the substrate to allow silica deposition onto the flat substrate. Nor does applicant disclose working examples that exclude the use of optical fiber preform substrates.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 109-122 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 109 at lines 3-4, the phrase "the support connecting the first movers to the substrates" lacks antecedent basis.

Claim 109 at lines 7, recites "heating the substrates and the particles" but there is no positive recitation of a step of forming "the particles".

Additionally, there is no nexus between the heaters in the chamber and the step of heating the substrate and particles nor a nexus between the support and the first movers.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. References A-E have been cited to show the state of the art.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is 571.272.1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CL

  
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